

REMARKS

1

The disclosure was objected to because of the recitation "or belt drive" on page 4, line 5. Accordingly, "or belt drive" has been deleted.

5

The Examiner also objected to the specification as failing to provide proper antecedent basis for the "low voltage" limitation. Inasmuch as claim 6, which describes "low voltage," is a part of the original disclosure, the specification has been amended to describe "a low voltage" limitation.

10

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brien '740. The Examiner stated that the patent to O'Brien '740 teaches a battery-powered sewer and drain cleaner 10. The O'Brien patent does not disclose that the motor 58 is a battery-powered motor. The O'Brien patent merely describes that the cleaning machine includes a motor driven, outer drum-like member.... At Col. 3, lines 61-62, motor 58 is described, but there is no suggestion whatsoever that the motor 58 is battery-driven. Col. 5, line 15, merely describes the motor 58 and does not remotely suggest that the motor is battery-driven. Accordingly, the Examiner's rejection on the basis of 35 U.S.C. § 103(a) of claims 1-7 is in error due to the lack of the battery-powered limitations found in claims 1-7.

15

The Examiner, in the last portion of his rejection of claims 1-7, suggests that it would have been obvious to a person of ordinary skill in the art to have modified O'Brien's cleaner such that the motor is a DC motor and includes a rechargeable battery mounted on the frame for powering the DC motor. Thus, the Examiner's rejection is not understood because, on one hand, the Examiner states that O'Brien

25

1 teaches a battery-powered sewer and drain cleaner but, on the other hand, states that
it would have been obvious to modify O'Brien's cleaner such that the motor is a DC
motor.

5 In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference must be considered in its entirety, i.e., as a whole, including
10 portions that would lead away from the claimed invention. W.L. Gore & Associates
Inc. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Distilling an
invention down to the "gist" or "thrust" of an invention disregards the requirement of
analyzing the subject matter "as a whole." *Id.*

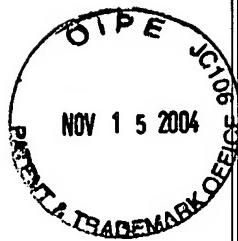
15 Even more damaging to the Examiner's modification of O'Brien is that the
Examiner has failed to point out any suggestion or motivation to modify the reference
in the manner suggested. MPEP § 2143.01. Obviousness can only be established by
combining or modifying the teachings of the prior art to produce a claimed invention
where there is some teaching, suggestion, or motivation to do so, found either
20 explicitly or implicitly in the references themselves or in the knowledge generally
available to one of ordinary skill in the art. *Id.* In Kotzab, the Federal Circuit decided
that the control of multiple valves by a single sensor rather than by multiple sensors
was a technologically simple concept. However, the Federal Circuit held that there
25 was no finding as to the specific understanding or principle within the knowledge of the

1 skilled artisan that would have provided the motivation to use a single sensor as the
system to control more than one valve. In re Kotzab, 217 F.3d 1365, 1370, 55
USPQ2d 1313, 1317 (Fed. Cir. 2000). (Emphasis provided).

5 The mere fact that a reference can be modified does not render the resulting
modification obvious unless the prior art also suggests the desirability of the
modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art to meet the claimed invention would have
been 'well within the ordinary skill of the art at the time that the claimed invention was
10 made because the references relied upon teach that all aspects of the claimed
invention were individually known in the art' is not sufficient to establish a *prima facie*
case of obviousness...." Ex parte Levingood, 28 USPQ2d 1300 (Bd. Pat. App. &
Inter. 1993).

15 Regarding the present invention, the Examiner has failed to show any
suggestion or motivation to modify the O'Brien reference. Accordingly, the Examiner is
requested to withdraw the rejection of claims 1-7 and to allow the same.

20 No fees or extensions of time are believed to be due in connection with this
Amendment; however, please consider this a request for any extension inadvertently
omitted and charge any additional fees to Deposit Account No. 502093.



1

Respectfully submitted,

DENNIS L. THOMTE
Registration No. 22,497
THOMTE, MAZOUR & NIEBERGALL
Attorneys of Record

5

2120 S. 72nd Street, Suite 1111
Omaha, NE 68124
(402) 392-2280

10

CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for DAVID W. MANNING ET AL., Serial No. 10/624,360, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313, on this 11^A day of November, 2004.

15

DENNIS L. THOMTE

20

25